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RESPONSE UNDER 37 C.F.R. § 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 3700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named  
Inventor : Pfeiffer et al.  
Appln. No.: 09/129,468  
Filed : August 4, 1998  
For : IMPROVED ASSEMBLY DEVICE FOR  
ASSEMBLING COMPONENTS  
Docket No.: S01.12-0448

Group Art Unit: 3729

Examiner: Minh N.  
Trinh

#24 / Response  
g2009/29/03

RESPONSE AFTER FINAL

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Commissioner for Patents  
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15 DAY OF September, 2003  
Dunde Zkval  
PATENT ATTORNEY

Sir:

This document is filed in response to the Final Office Action mailed July 14, 2003. Claims 1-15 and 21-28 are pending in the application. Claims 23-28 are allowed and claims 4-15 and 22 are objected to as being dependent upon a rejected base claim but allowable if rewritten in independent form to include all of the limitations of the rejected base claim and any intervening claim. Claims 1-3, 21 and 27-28 are rejected. Applicants respond to the rejection of claims 1-3, 21 and 27-28 as follows.

Claims 1-3 and 21 were rejected under 35 U.S.C. § 102(e) as being anticipated by Chuang et al, U.S. patent No. 6,094,804 as set forth in the previous Office Action, paragraph 6. Claims 1-3 recite *inter alia* a carousel base rotationally coupled to a frame and a carousel coupling device to removably couple a component carousel to the carousel base. Claims 1-3 were rejected on the basis that Chuang et al. disclose an apparatus comprising a frame

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278 connectively attached to the carousel 316 with base. Thus the recited basis for the rejection actually teaches away from the claimed subject matter reciting a carousel coupling device to removably coupled a carousel to a carousel base rotationally coupled to a frame and thus fails to establish a *prima facie* basis to reject the claims.

Claims 1-3 were also rejected on that basis that Chuang discloses a "carousel coupling device that couple [sic] the carousel base to the frame" which does not establish a *prima facie* basis to reject claims reciting a carousel coupling device that removably couples a carousel to a carousel base rotationally couple to a frame. Claims 1-3 were also rejected on the basis that Chuang teaches a carousel coupling device to removably couple to the carousel base (See Office Action dated 2/24/2003 and Response to Arguments in the Final Office Action of July 14, 2003). Claims 1-3 do not recite a removable carousel coupling device to removably couple to the carousel base. Instead claims 1-3 recite a carousel coupling device to removably couple a carousel to a carousel base rotationally coupled to a frame and thus the recited rejection fails to establish a *prima facie* basis to reject the claims.

Further claims 1-3 were rejected based upon col. 17, lines 11-25 of Chuang. Col. 17, lines 11 -25 of Chuang disclose a carousel 316 and a vacuum assisted end effector which picks up shims from carousel 316 and delivers the shims to a shim attachment assembly. As disclosed in col. 17, lines 11-25, carousel and vacuum assisted end effector do not teach or suggest a carousel coupling device to removeably couple a carousel to a carousel base rotationally coupled to a frame as claimed and thus fails to establish a *prima facie* basis to reject the claims.

Claim 21 is a means-plus-function claim which is interpreted

to include the corresponding structure disclosed in Applicants' specification and equivalents. Claim 21 was rejected on the basis that Chuang teaches a means for intermittently stocking a carousel with a supply of components for assembly by an assembly arm 318 without regard to the corresponding structure disclosed in Applicants' specification. Accordingly, the Office Action fails to establish a *prima facie* basis to reject claim 21 based upon *In re Donaldson*, 29 U.S.P.Q. 2d 1845 (Fed. Cir. 1994) and the Supplemental Examination Guidelines of June 2000. Furthermore claim 21 was rejected on the basis that Chuang teaches a robotic arm 318 including a vacuum assisted end effector for removing (or picking up) shims from a carousel for assembly in an attachment assembly. In contrast claim 21 recites a means for intermittently stocking an assembly apparatus with a supply of components for assembly by the assembly arm which is not taught nor suggested by the robotic arm 318 and end effector of Chuang which removes shims from the carousel for assembly.

Claims 27-28 were rejected under 35 U.S.C. § 102(e) based upon Chuang. Claims 27-28 recite *inter alia* a carousel base rotationally coupled to a frame and a carousel coupling device to removably couple a component carousel to the carousel base and were rejected on the basis that Chuang et al. disclose an apparatus comprising a frame 278 connectively attached to a carousel 316 with base. As previously discussed, the recited basis for rejection actually teaches away from the subject matter claimed.

Claims 27-28 were also rejected on that basis that Chuang discloses a "carousel coupling device that couple [sic] the carousel base to the frame" which does not establish a *prima facie* basis to reject claims reciting a carousel coupling device that removably couples a carousel to a carousel base rotationally

coupled to a frame. Claims 27-28 were also rejected on the basis that Chuang teaches a carousel coupling device to removably couple to the carousel base. Claims 27-28 do not recite a removable carousel coupling device to removably couple to the carousel base. Instead claims 27-28 recite a carousel coupling device to removably couple a carousel to a carousel base rotationally coupled to a frame and thus the rejected rejection fails to establish a *prima facie* basis to reject the claims.

Claims 27-28 were also rejected on the basis that Chuang discloses an end effector coupled to a robotic arm to unload shims from a carousel as set forth in col. 17, lines 11-25 of Chuang. Col. 17, lines 11-25 do not teach or suggest a carousel coupling device to removably couple a carousel to a carousel base rotationally coupled to a frame as claimed.

Claim 28 further recites a component carousel including a plurality of latching assemblies to removably couple a plurality of component containers thereto and was rejected on the basis that Chuang inherently discloses a plurality of latching assemblies being coupled to a plurality of component containers - where it is noted "that the attached assembly (316) of the reference read [sic] on the claimed carousel including plurality [sic] latching couple [sic] to a plurality of containers. To reject claims under 35 U.S.C. § 102 based upon inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill" *Continental Can Co. v Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). Marked up FIG. 10 has a reference to latches but does not establish that the subject matter of the claims including a plurality of latch assemblies to removably couple a plurality of containers to a carousel is necessarily taught or present in the

thing described to support a basis to reject claim 28 based upon inherency.

Based upon the foregoing, Applicants respectfully request allowance of claims 1-3, 21 and 27-28.

The Director is authorized to charge any fee deficiency required by/ this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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